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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,075	01/06/2000	MAKOTO SATO	0670-221	4639

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2653

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

WHT

Office Action Summary	Application No. 09/462,075	Applicant(s) SATO, MAKOTO	
	Examiner Aristotelis M Psitos	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's response of 1/3/05 has been considered with the following results.

Information Disclosure Statement

The IDS of 1/3/05 has been reviewed. The examiner regrets his inability to explain why the written notifications have been crossed out. As stated in the advisory action, these documents are not "PRIOR ART". Hence they will not be printed on the face of any patent. If applicant desires such to be printed, then the examiner recommends following the procedure in MPEP ¶ 609.

With respect to applicant's concern of the prior art recited in the above written notifications, the examiner did not mean to convey that the cited prior art contained therein have not been considered. To the extent that prior art is present, they have been considered. Since there are documents referred to in the above notifications and are prior art, and are in compliance with MPEP ¶ 609 they have been initialed – see the initialed 1449 forms dated as being considered on 6/3/04, 11/18/03 and 7/24/01 (copies attached hereto) and will be printed on the face of any maturing patent from this application. Hence the examiner concludes that the prior art has been properly considered.

Again, if applicants desire the above submitted written notifications to be printed on the face of any patent maturing from this application, appropriate steps for doing so are outlined in the above MPEP section.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The following analysis is made.

Figure 2 describes the operation of the system of figure 1. As noted in figure 1, the first controller is element 7 and the buffer region is listed as element 5. As disclosed – see paragraphs 50-52 in the US PUBS equivalent document (2003/0174591A1, the capturing key is interpreted as the claimed first key. Applicant has presented arguments – see page 8 of the latest communication. However, as further claimed, a second key is recited in lines 8-9 of claim 1. This key is not clearly shown in any figures, but is noted in figure 2 at step 56. This does not agree with the disclosure, i.e. as claimed music signal having already been recorded on the recording medium is not present, see paragraph 52 of the above noted US Pubs document. The third key is the “call” key

Similar limitations are found/recited in independent claims 4 and 7. The dependent claims fail to clarify the above and fall accordingly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1,4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto considered with Yuen et al.

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The following analysis is made:

Claim 1

Matsumoto

A title input device for a recording medium,
comprising:

see title/abstract

a receiving tuner that receives text broadcasting
and outputs received text information;

figure 1, element 1, see
col. 1 starting at line 50

a display that displays the received text information
output from the receiving tuner;

figure 1, element 57

a first system controller that stores the received text
information in a capturing buffer region when
a first key instructs to selectively capture the received text
information;

figure 1, element 15
and Yuen et al below
inherently present
in Matsumoto

a second key that selects a target unit of the
recording medium to input a title, a music signal having
already been recorded on the recording medium;

keypad 65, see col.
5 lines 23-33, in
Matsumoto

a third key that instructs to call desired received text
information from the capturing buffer region; and

see col. 5, lines 35-45
inherently present

a second system controller that reads the desired
received text information instructed to be called by
the third key from the received text information stored
in the capturing region buffer and records the desired

figure 1, element 35

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received text information in the recording medium as a title name of the target unit selected by the second key, in response to operations of the third key and the second key.

With respect to claims 1 and 4, Matsumoto discloses a broadcast tuner/receiver, which is appropriately controlled by element 15. Hence the use can select whatever he would like to listen to. As disclosed therein, appropriate audio information and accompanying text is received.

Furthermore, this information is recorded onto element 3 for instance which is also under its own controller – element 35 for instance. The examiner interprets that this controller provides a user with the ability to select a “target” unit (the record so located in unit 3) and provides for the ability of subsequently recording information thereon. Since the information is audio, the examiner concludes that audio information is previously recorded onto the disc.

There is no specific mentioning that there is a buffer for temporarily storing the incoming information from the receiver/tuner unit, the examiner supplies Yuen et al who provides such an ability in his over all system, so as to buffer/temp. store the selected information prior to recording it upon his record medium, see col. 21, the entire column.

It would have been obvious to modify the base system of Matsumoto with the above teaching from Yuen et al, motivation is to provides a user with greater flexibility by permitting him to edit the information prior to a final recording. Editing of information prior to recording is a well-known ability in the recording arts and considered taught by Yuen et al.

With respect to the keys as claimed, the examiner concludes that such elements, keys are provided in Yuen et al – see the description of elements with respect to the keyboards, either 32, 32 a, or alternatively, the keyboard with the remote control unit. Hence which key is first, capture/save, second key – designate a target unit / record, and a third key – store to targeted unit is present.

With respect to method claim 7, the limitations are met when the above system operates.

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Response to Arguments

Applicant's arguments filed 1/3/05 have been fully considered but they are not persuasive.

Applicant's arguments focuses on the newly inserted "selectively" capture ability of the first key. The examiner concludes that such is by necessity in the base system, i.e., a user selects a channel/broadcast signal, and hence inherently since the system can receive a plurality of signals such provides for the ability to "selectively capture" the received text.

Since title input is provided for by the Matsumoto reference, the examiner disagrees with applicant with respect to the absence of such a second key.

3. Claims 2,3,5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 4 above, and further in view of either JP 3-233670 or JP 9-146528.

The ability of "deleting" duplicate, unwanted characters in a text is taught by either of the noted secondary systems to JP 3-233670 or JP 9-146528.

It would have been obvious to modify the base system of the primary references to either Young et al or Yuen et al with the additional duplicate deletion ability as noted above in the secondary references, motivation is to eliminate any unnecessary text for display.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the rejection as further stated above in paragraph 2.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Amano et al – see the disclosure starting at col. 8 line 47 to col. 9 line 54 for disclosing a recording system having a "title" input and save ability.

Additional examples of "save as" key inputs is taught by either Matsubayashi et al or Usui.

In Matsubayashi et al, applicant's attention is drawn to figure 3 and keys 33 and 37 and the associated disclosure.

Alternatively, the patent to Usui, at figure 17, see the description of the 2F-1 key teaches the

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ability of having a "save as" function for recording title information during the appropriate operation.

Cragun et al – see the discussion with respect to figure 7, his ability to edit his previously established profile, hence an second key permitting the entry of "title" information.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner

